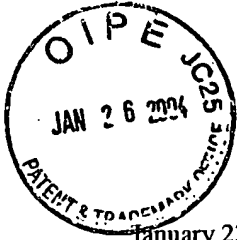


WINSTEAD



January 23, 2004

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Appellant: John Brian Pickering
Title: Voice Processing System
Docket No.: GB9-1999-0107US1 (a/k/a 7036-P145US)
Serial No.: 09/696,485
Examiner: Susan Iris McFadden

Filing Date: 10/25/2000
Group Art Unit: 2654

Docket No.: 7036-P145US

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Transmitted herewith are the following:

1. Return Receipt Postcard
2. This Transmittal Letter (2 pages) (in duplicate)
3. 5 pages of Reply Brief (in triplicate) along with 4 pages of attachment marked as Exhibit A

for the above-identified Application.

- ☒ No additional fee is required.
- ☒ If the fee has been calculated incorrectly, the Commissioner is hereby authorized to charge any insufficiency of payment of the following fees associated with this communication, or credit any overpayment, to Deposit Account No. 50-0563 (7036-P145US) in the name of IBM Corporation. A duplicate copy of this transmittal letter is enclosed.

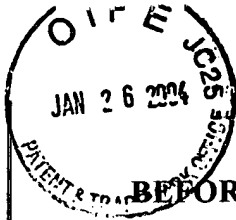
CERTIFICATION UNDER 37 C.F.R. § 1.8
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Signature

Respectfully submitted,

Michael P. Adams
Attorney for Applicant(s)
Reg. No. 34,763

MPA:wk
Enclosure(s)



PATENT

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: John Brian Pickering
Assignee: IBM Corporation
Title: Voice Processing System

Serial No.: 09/696,485

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REPLY BRIEF

Dear Sir:

In response to the Examiner's Answer having a mailing date of November 26, 2003 (Paper No. 10) with a two month statutory period for response set to expire on January 26, 2004, Appellant responds as follows.

ARGUMENT

A. The teachings of Van Tichelen do not support the 102(e) rejections of claims 1-11, 13-24, and 26-27.

With regard to the 35 U.S.C. § 102(e) rejections based on the Van Tichelen patent, the Examiner continues to fail to cite to any teachings which establish that Van Tichelen provides barge-in capability for "terminating the playing out of the prompt" based on "said text satisfying said one or more conditions, otherwise, continuing the playing out of said prompt." As stated in Appellant's Appeal Brief, although Van Tichelen discloses that it supports barge-in capability, there is no evidence that Van Tichelen teaches barge-in with the aforementioned capabilities. In fact, the barge-

in functionality in Van Tichelen appears to be limited to barge-in occurring upon any input or response as opposed to corresponding text satisfying one or more conditions. The Examiner has offered no evidence to rebut this conclusion.

B. The Examiner improperly makes new arguments and cites new art.

In an apparent attempt at filling the holes in the teachings of Van Tichelen, the Examiner has argued that "one of ordinary skill in the art familiar with barge-in systems knows that systems that accurately recognize words which satisfy desired conditions turn off the prompt being generated." Thus, the Examiner suggests that the teachings not found in Van Tichelen are general knowledge. However, during the prosecution prior to this Appeal, the Examiner improperly made conclusory statements about what is "basic knowledge" and did not provide adequate support in the record for these positions. *See In re Sang-Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). Recognizing this flaw in her position, in the Answer to Appellant's Brief the Examiner cites five new patents, not previously cited, to support the Examiner's alleged Official Notice of what is "basic knowledge." No formal statement of rejection has ever been made regarding these five newly cited patents. For the reasons discussed below, these five newly cited patents cannot support the 35 U.S.C. § 102(e) rejections.

Since the Examiner never cited these five references prior to her Answer, the Board cannot consider their teachings and suggestions. "Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection." Manual of Patenting Examining Procedure ("MPEP") § 706.02(j), citing *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

Furthermore, "37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. . . . A new prior art reference cited for the first time in an examiner's answer generally will constitute a new ground of rejection." *See* MPEP § 1208.01. MPEP § 1208.01 further

provides that: "Any allegation that an examiner's answer contains an impermissible new ground of rejection is waived if not timely (37 CFR 1.181(f)) raised by way of a petition under 37 CFR 1.181(a)." Accordingly, Appellant is filing concurrently herewith a petition under 37 CFR 1.181(a) objecting to the Examiner's new grounds of rejection. A copy is attached hereto as Exhibit A.

Notwithstanding the foregoing, the newly cited patents do not support the Examiner's position of what was "basic knowledge" in the prior art. Appellant's patent application was filed October 25, 2000 but claims priority to a corresponding U.K. patent application, Serial No. 9928011.7, filed November 27, 1999. However, the Examiner's argument of what was "basic knowledge" focuses on teachings in newly cited U.S. Patent No. 6,510,417 to Woods et al. The Woods patent has a filing date of March 21, 2000 and therefore does not even qualify as prior art to the subject patent application.

With regard to the rejection of claim 27, the Examiner's Answer provides a new basis for this rejection, not previously disclosed, by citing to new alleged teachings in the Van Tichelen patent. Accordingly, for the reasons discussed above, the Examiner's untimely argument should be treated as another new ground for rejection, and should not be considered by the Board. However, even if the Examiner's argument can be considered, it does not adequately support rejection of claim 27. The Examiner again takes the position that Van Tichelen inherently teaches an aspect of Applicant's claimed invention. In particular, the Examiner asserts that Van Tichelen inherently teaches "determining if said audio input is speech input." However, the Examiner again does not provide sufficient rationale or evidence necessary to show inherency. See MPEP § 2112 ("examiner must provide rationale or evidence intending to show inherency"). The Examiner has not offered sufficient evidence that makes it clear that the missing descriptive matter is necessarily present in the Van Tichelen reference.

C. The Examiner still has not met the burden of factually supporting the motivation to combine Van Tichelen and Garner.

The Examiner also still has not satisfied the burden of factually supporting the alleged motivation to combine the Van Tichelen and Garner patents. For example, the Examiner still has not cited to any express teachings within these patents which support a motivation to combine these patents to achieve Appellant's claimed invention. In the Examiner's Answer, the Examiner engages in impermissible hindsight. The Examiner merely states that: "It would be obvious to combine these references because they would produce a system (mobile phone or computer interface) that can operate reliably in a noisy environment." The Examiner's statement is not sufficient to satisfy the burden of proof.

With regard to claims 12 and 25, the Examiner is correct that the phrase "whether to continue or terminate playing out of said prompt" is not a direct quote from these claims. Appellant apologizes for any confusion. Appellant quoted the language to emphasize that the purpose of distinguishing between noise and speech in Appellant's claimed invention is different from the purpose in Garner. This leads to the conclusion that there is no motivation to combine Garner and Van Tichelen to obtain Appellant's claimed invention. It is clear from a reading of claim 12, in light of claims 7-11 and 13, and from a reading of claim 25, in light of claims 20-24 and 26, that one purpose of distinguishing between noise and speech in Appellant's claimed invention is that it aids in the determination of whether a relevant user response has been received and whether to continue or terminate playing out of the prompt. Garner teaches, on the other hand, distinguishing between speech and noise, for the purpose of not transmitting noise.

CONCLUSION

For the above reasons and the reasons stated in Appellant's Appeal Brief, Appellant respectfully submits that rejection of pending Claims 1-27 is unfounded. Accordingly, Appellant requests that the rejection of Claims 1-27 be reversed.

This Reply Brief is submitted in triplicate.

Respectfully submitted,



Michael P. Adams
Attorney for Appellant(s)
Reg. No. 34,763

CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence (along with any item referred to as being enclosed herewith) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 23, 2004.



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